

No. 11642.

IN THE

# United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT

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YORK CORPORATION,

*Plaintiff-Appellant and Cross-Appellee,*

*vs.*

REFRIGERATION ENGINEERING, INC.,

*Defendant-Appellee and Cross-Appellant.*

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Opening Brief of Refrigeration Engineering, Inc., Defendant-Appellee and Cross-Appellant.

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## Opening Brief of Refrigeration Engineering, Inc., Defendant-Appellee and Cross-Appellant.

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In these appeals, York Corporation\* has appealed from a judgment of the District Court adjudging valid and infringed by York Corporation claim 13 of the McAdam Patent No. 2,219,393 for a Defrosting Device, and Refrigeration Engineering, Inc., has appealed from so much of that judgment as adjudges claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12 and 14 of that patent invalid.

The action was commenced by York Corporation filing its complaint for Declaratory Judgment. Refrigeration Engineering, Inc., answered the complaint, admitted the

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\*Refrigeration Engineering, Inc., Defendant, Cross-Complainant, Appellee and Cross-Appellant, will be referred to herein as "Refrigeration Engineering"; York Corporation, Plaintiff, Cross-Defendant, Appellant and Cross-Appellee, will be referred to herein as "York Corporation."

existence of an actual controversy between the parties as to the validity and infringement of the patent, and filed its cross-complaint for infringement. Thus, the position of the parties in the usual patent infringement suit was reversed. At the trial of this cause by stipulation Refrigeration Engineering proceeded initially in the presentation of its evidence as owner of the patent asserting infringement on its cross-complaint.

### **Jurisdiction.**

The District Court had jurisdiction of the "Actual Controversy" arising under the patent laws (Judicial Code 24, 28 U. S. C. A. 41(7)), and under the Declaratory Judgment Act (Judicial Code 274(d), 28 U. S. C. A. 400). This Court has jurisdiction of the appeals (Judicial Code 129, 28 U. S. C. A. 227). Both appeals were timely. The judgment was entered March 24, 1947 [I. 26].\* Refrigeration Engineering's notice of appeal was filed April 22, 1947 [I. 27] and York Corporation's on April 23, 1947 [I. 28], both within thirty (30) days.

### **Statement of the Case.**

The McAdam patent relates to an invention of a "defrosting device" for removing frost and ice from the coils and fins of a refrigerating unit located within a space continually maintained at a temperature below the freezing point of water. "Defrosting" means in this art the removal of frost or ice from the surfaces of the refrigeration device. Frost or ice collecting upon such surfaces effectively insulates the refrigerating device, stopping the

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\*The printed record herein is referred to by Roman numerals designating the volume, followed by the reference page numbers.

refrigeration. The invention involves the novel concept that this may be accomplished in a practical and efficient manner by flushing the coils with ordinary tap water, care being taken to insure the draining of the supply and drain lines immediately so that the water and melted frost and ice are not permitted to come to rest within the device. The McAdam device is "self-draining." Should the water or melted frost or ice be permitted to remain in the device it will freeze and leave the whole device useless.

The principle upon which this invention is based is that to change water at 32° F. into ice at 32° F. it is necessary to extract 144 B.T.U. of heat per pound from the water. To change the temperature of water 1° F. requires the mere extraction of one B.T.U. per pound. The McAdam patent in ~~utilizing~~ <sup>utilizing</sup> this principle solved a problem in below-freezing refrigeration which for many years remained without solution.

In the McAdam patent [IV. 1428] tap water at ordinary temperature existing in the supply pipe is conducted through pipe 17a by a valve 18 into the freezing chamber or space 10 by an inclined pipe 17. The water from the pipe 17 is sprayed through a spray header 15 over the frost and ice collected upon refrigerant coils 5 and fins thereof. The water passing over said coils and fins gives up heat, melting the frost and ice from the coils and fins. Dropping through the coils the water and melted frost and ice are caught in a pan 8 and pass through an inclined drain pipe 11-12, and are discharged outside the refrigerated space. The water and melted frost and ice are at no time allowed to stop within the refrigerated space 10 as the device is self-draining. The water sprayed over the coils gives up heat (less than 144 B.T.U.'s per pound) to melt the ice and frost. The water moving through the

system thus does not remain for a time sufficient to extract its entire heat of fusion (144 B.T.U.'s per pound) and does not freeze.

To provide continuous and efficient drainage, the supply line 17 to the spray head 15 is inclined and is provided with an ordinary three-way valve 18, one port of which leads to the water main and the other to the drain. This valve is normally open so that the instant the supply water is shut off, the inclined supply line drains outside the refrigerated space. The drain line 11-12 from the pan 8 is inclined and the water and melted frost and ice will continually drain from the refrigerated space. It is thus assured that both the supply to and drain from the refrigerating unit are "self-draining."

The evidence shows that prior to its introduction by McAdam the art was struggling with the problem of defrosting coils. Many systems were used, some were tedious and expensive. Some systems were dangerous as was the reverse cycling of the gas in the refrigerating system. One system was flushing the frost and ice off the refrigeration coils with a corroding salt brine. Another was subjecting the frost and ice to a blast of warm air. Another was manually chopping off the ice. [Cf. I. 116; Ex. R, IV. 1498; Ex. S, IV. 1500-1501.]

The record contains full surveys and explanations of the knowledge of the art just prior to the introduction of the McAdam invention. Skilled refrigerating engineers were concerned with the problem of defrosting such coils in such low temperature units and had published articles on the then known methods for so doing.

In the article entitled "Methods of Defrosting Various Types of Hardening Room Coils" by John C. Consley, Engineering Division, York Ice Machine Corporation

(York Corporation's earlier name [I. 121]), published in the September, 1934, issue of the "Ice Cream Review," the author stated the then known methods of defrosting to be:

1. Mechanically scraping or cutting the frost off [IV. 1476];
2. Air blasts from high pressure hoses [IV. 1477];
3. Spraying with a strong brine, said to be objectional [IV. 1477];
4. Spraying with hot water or steam, listing five serious objections [IV. 1477];
5. The hot gas method [IV. 1477-1478]; listing three subtypes [IV. 1478-9; Pltfs. Ex. 113, IV. 1476-9; and Defts. Ex. R, IV. 1509-1511].

Again, in the article "Defrosting: A survey of All Methods and Systems," by Siegfried Ruppricht, published in Refrigeration Engineering, the publication of the American Society of Refrigeration Engineers in June, 1936, and presented at the June, 1936 meeting of that society, there appears what purports to be an all-inclusive survey of the art as it stood at that time. A great number of expedients resorted to in such defrosting is described in detail and it is significant that the only mention of water defrosting is in the paragraph reading as follows:

"7. In emergency cases, service men pour water over thickly frosted coils, as is customary with metallic ice-cube trays, and this method could be employed in a permanent installation were it not for the trouble caused by water freezing in the piping during regular operation." [IV. 1512.]

Mr. Siegfried Ruppricht testified for Refrigeration Engineering, Inc., and told of the extensive survey he made of the art, prior to this publication [I. 138]. Mr. Ruppricht further testified that he was requested to make this survey and write this article by the Society of Refrigeration Engineers [I. 139]. The problem was then acute.

The state of the art just prior to the introduction of the McAdam invention is well established and it did not include knowledge of the McAdam invention.

There has been a remarkable success for that invention, but it was not immediately and easily achieved. The industry was skeptical and even went so far as to require Refrigeration Engineering, Inc., to offer guarantees of satisfaction\* with each installation. [Finding of Fact No. 9, I. 15; see also I. 59, 70-71; Ex. D, IV. 1484; I. 124, 153-4, 156.]

Qualified experts, even experts then in the employ of the York Corporation, doubted the practicality of the McAdam invention even after it had been demonstrated [I. 57, 152-3, 194-7, 241].

When the operability of the invention was once demonstrated, it then went into widespread commercial use. This is shown by the fact that the Refrigeration Engineering Corporation has progressed since 1938 from a net worth of \$57,000 to a net worth of \$250,000, and its sales have risen from \$200,000 per year to \$1,000,000 per year, forty per cent of these sales being the patented units [III. 1093]. This success was achieved with little

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\*With its early installations Refrigeration Engineering, Inc., was required to give guarantees that if the water defrosting was unsatisfactory it would be removed and replaced with a conventional system (record as cited).



or no advertising [III. 1092]. Licensees had paid to the end of 1945 license fees in the sum of \$52,345.75 [I. 77]. After the success of the McAdam invention had thus been commercially proven, York Corporation itself used water defrosting in 11% of its sales since 1940, exclusive of military sales [III. 1032, 1045-6].

During the war approximately 50,000 McAdam type water defrosting refrigerating units were built for the armed services [I. 189, and Finding of Fact 15, I. 16], and at the Haslett Warehouse in Oakland, one of Refrigeration Engineering's first installations, 30,000-45,000 pounds of butter and blood plasma daily were handled [I. 172] during the war in a room required to be maintained at 20° below zero F. [I. 163].

There is no substantial issue with respect to infringement. A stipulation was entered into between the parties [Ex. CC, IV. 1527] describing two types of water defrosting refrigerating equipment, only the first type of which is involved in this suit. This stipulation admits the manufacture, sale and installation within the Southern District of California and elsewhere of defrosting devices operating within below freezing refrigerated spaces, and described as follows [IV. 1528-9]:

“Plaintiff has supplied water defrosting connections with its standard sectional coil unit, where the unit was installed to maintain a temperature well below freezing in the *refrigerated space*.

“This standard unit is made up of three sections: The bottom or drip pan section, the central or coil section, and the top or fan section. When equipped for water defrosting, the top or fan section is the same as in the standard unit, but the shallow condensate drip pan is replaced by a 6-inch drip pan,

which is drained by a 2½-inch line to the sewer. The drain line is trapped outside the refrigerated space to prevent warm air from being drawn in during the operation of the unit.

“The central or coil section is provided with a spray header, which has been blocked in in solid color on Exhibit A attached (Drawing No. F-P-8283). The header consists of a length of 2 inch pipe, capped at both ends, which runs along the top of the coil section. From the top of this pipe, extending laterally across the top of the coil, are eight ½” perforated pipes capped at the end. (Details of the laterals are shown on Exhibit B, drawing No. SP-8042-V.)

“As shown in Exhibit C (Drawing No. 178928Y), a 2 inch supply line extends down from the spray header to the bottom of the coil where it passes through the wall of the coil section and is connected, outside *the refrigerated space*, to the city water supply.

“Located in the supply line outside the refrigerated space between that space and the main control valve is a standard 2 inch three-way cock, shown in Exhibit D (Drawing No. J598). When the water is turned on and the three-way cock is in the ‘open’ position, water is supplied to the spray header and directed over the coil by means of the spray laterals. The water and melted ice and frost which falls by gravity to the drip pan below the coil, drains to the sewer by means of the 2½ inch drain line. When the water is turned off at the control valve and the three-way cock is turned to the ‘closed’ position, the water in the spray laterals, header and supply pipe is permitted to drain back through the three-way cock to the sewer. The spray laterals, header and supply pipe, as well as the drain line from the drip pan, are all pitched so as to permit efficient drainage.



Rubber hosing replaces the pipe in those sections of the supply and drain lines which pass through the wall of the *refrigerated space*, as shown in Exhibit D (Drawing No. J598).” (Emphasis ours.)

The record contains charts, Ex. DD [IV. 1540-1546] which are colored and numbered to illustrate how each of the elements of claims 1, 2, 5, 6, 7, 8, 12 and 13 are found in the identical form called for in the claims in the infringing units.

York’s second point to be relied upon [III. 1109] urges noninfringement. We understand this to be based upon an asserted failure to supply to its customers “a refrigerated space.” The foregoing stipulation, Ex. DD, is the only description of the infringing devices in the record and therein it is stipulated that:

“Plaintiff has supplied water defrosting connections with its standard section coil unit, where the unit was installed to maintain a temperature well below freezing in the *refrigerated space*.”

No request for relief from the stipulation was ever made.

York Corporation’s defense to the McAdam patent in suit is based upon certain enumerated prior patents and prior uses. The District Court found [Finding 20, I. 17]:

“20. That plaintiff has not sustained the burden of proof of establishing either prior manufacture, use, sale or knowledge of the invention of the McAdam patent in suit.”

Further detailed findings were entered with respect to each of the asserted prior uses, finding:

That the so-called Gayley Dry Blast was not self-draining [Finding 21, I. 17], did not involve below freezing temperature during defrosting [Findings 23, 24, 25, 26, 27, I. 17-18];

That the so-called Polar Ice installation was not self-draining, was not provided for refrigeration below the freezing point of water and was abandoned and discarded [Findings 28-32, I. 18-19];

That the Swift & Company installation did not involve refrigeration below the freezing point of water, was not self-draining and on the contrary, where such below freezing refrigeration was used by Swift & Company, another system of defrosting was employed [Findings 33-36, I. 19-20];

That the Yamhill installation was an abandoned experiment [Finding 38, I. 20], was not established to have been made, used or sold [Finding 36, I. 20], and it was established that several methods of defrosting were attempted unsuccessfully and abandoned [Finding 39], and that the installation is now using hot air defrosting.

Further, with respect to this "Yamhill" installation, it was found that when water defrosting was attempted, the coils were *outside* of the refrigerated space [Finding 40, I. 20], and it was *not* established that the temperature thereof was below freezing [Finding 41, I. 21]. The at-

tempt to use water defrosting was unsatisfactory [Finding 42]. This installation was not paid for [Finding 43], was forgotten and never repeated [Finding 45].

Further, although York Corporation's witnesses had records of the facts, such records were not produced and it never was established just when the attempt to use water defrosting at Yamhill began and ended [Finding 46, I. 21]. The chief witness to this alleged prior use was impeached and his testimony found unworthy of belief [Finding 47, I. 22].

York Corporation also relies upon two prior patents, the United States patent to Wenzl, No. 2,097,851, and the French patent to Jensen & Roser, No. 800,640, as disclosing "The use of water to defrost at below freezing temperatures" [Point 10, III. 1111]. Neither of these patents anticipates the patent in suit in that no structure is disclosed in either by which they are "self-draining," and in that, failing to state the temperature conditions maintained during defrosting, they do not even involve the problem solved by McAdam.

The District Court found as a fact [Finding 48, I. 22] and as a conclusion of law [*id.* 23] that claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12 and 14 of the McAdam's patent are invalid as not defining the entire invention of the McAdam patent. As a matter of law, the District Court erred in this.

Further, toward the conclusion of the trial, the plaintiff moved to amend its complaint to allege that defendant is

barred from relief because it has misused the patent in suit in an effort to control competition in unpatented devices [III. 1053]. This motion was denied [III. 1060, 1062, 1063]. This motion was based on an assertion by counsel for plaintiff that the evidence showed that Refrigeration Engineering, Inc., was selling less than the entire patented combination. The District Court concluded that the evidence was to the contrary and on this ground and on the ground that the motion was untimely, denied the motion [III. 1061].

### **Questions Involved on York Corporation's Appeal.**

1. Is the patent in suit invalid in view of the prior uses of the "Gayley Dry Blast" system, the Swift & Company, Elmira, New York, installation, the Polar Ice & Fuel Co. installation at Indianapolis, or the Trullinger and Eustice installation at Yamhill, Oregon?

2. Is the patent in suit invalid for want of patentable invention?

3. Is the patent in suit infringed by the York Corporation's "Unit sold to private concerns" described by stipulation?

4. Is the patent in suit anticipated by the prior United States patent to Wenzl or the prior French patent to Jensen & Roser?

5. Did the District Court err in denying plaintiff's motion to amend its complaint to allege a misuse of the patent in suit?

## Question Involved on Refrigeration Engineering, Inc.'s, Appeal.

1. Did the District Court err in holding that claims 1-12 and 14 are invalid as failing to define the entire invention of the McAdam patent?

### Summary of Argument.

The District Court found as a fact that the McAdam patent involved invention. The question of invention is one of fact, and this finding is in accord with the overwhelming weight of the evidence. The McAdam patent meets the tests for invention laid down by the courts; it has largely supplanted the earlier salt-brine method; it filled a long felt want; it is simple, but was long overlooked, and prior to its introduction the art was struggling along with inefficient, cumbersome and sometimes dangerous expedients; initially the art was skeptical of the invention, not believing it would work, but it has gone into widespread commercial use; competitors have paid large sums as license fees, and York Corporation's slavish infringement is evidence of what York Corporation thinks of the invention.

The District Court properly concluded that the McAdam invention was novel, useful and not anticipated by anything existing in the prior art.

The McAdam invention is not anticipated by the "Gayley Dry Blast" installations, as these installations were not "self-draining"; were not maintained below freezing during defrosting; and involved a system of vanes or doors for shutting off and isolating the several compartments during defrosting.

The McAdam invention is not anticipated by the Polar Ice Co. installation. It was not self-draining; it was

not a below-freezing installation; it was abandoned and never revived.

The McAdam invention is not anticipated by the Swift & Co. installation. This was another above-freezing installation and was not self-draining. Swift & Co. had a below-freezing room but in that used a different method of defrosting.

The McAdam invention is not anticipated by the “Yam-hill” installation. This installation was found to be an unsuccessful, abandoned experiment and did not involve below-freezing temperatures during defrosting, but used a system of vanes and doors to isolate the unit during defrosting.

The McAdam invention is not anticipated by the U. S. patent to Wenzl or the French patent to Jensen and Roser. These patents do not embody the McAdam combination and are mere inoperative suggestions.

York Corporation has infringed claims 1, 2, 5, 6, 7, 8, 12 and 13 of the McAdam patent. The facts with respect to infringement are not in controversy, being fully established by stipulation.

The District Court erred in concluding that claims 1-12 and 14 of the McAdam patent are invalid as failing to define the entire invention of the McAdam patent. Claims 10 and 11 clearly contain the full invention, and when properly construed by reference to the specification, as required by law, so do each of the others.

The District Court did not err in denying York Corporation's motion to amend its complaint to allege misuse of the patent in suit. The evidence does not establish such misuse; and also the motion was untimely.

## ARGUMENT.

### I.

#### The District Court Found as a Fact That the McAdam Patent Involved Invention.

“\* \* \* The question whether an improvement requires mere mechanical skill or the exercise of the faculty of invention is one of fact; and, in an action at law for infringement, is to be left to the determination of the jury. \* \* \*” (*Thompson Spot Welder Company v. Ford Motor Company*, 265 U. S. 445, 446, and citing cases.)

The District Court found:

“18. That it required the exercise of inventive faculty to invent the combination as defined by Claim 13 of the Letters Patent No. 2,219,393.” [Finding 18, I. 16.]

This finding is in accordance with the overwhelming weight of the evidence. The McAdam invention meets all of the tests laid down by the courts for determining the exercise of invention as distinguished from the mere skill of the calling.

The closest approach to the McAdam invention in the prior art is the salt brine method of defrosting in which a concentrated salt solution is sprayed over the coils, the salt being added to reduce the freezing point of the liquid and prevent its freezing. The District Court heard testimony comparing this method of defrosting with the McAdam invention. The Haslett Warehouse in Oakland contains four large refrigerating rooms, each of identical size. In three of these rooms exposed pipes containing refrigerating brine were used. In the fourth of these rooms the McAdam invention as embodied in



Refrigeration Engineering, Inc., Recold System was used. The witness, James R. Payne, testified on behalf of Refrigeration Engineering, Inc., and described defrosting in these rooms. In one attempt at defrosting the old units with salt brine the witness used up \$150.00 worth of salt (calcium chloride). The job took three days and nights. It was necessary to remove the butter from the room as the refrigeration was shut off and the temperature rose to 30° above zero [I. 160-161]. In contrast to this, in the fourth room where the patented invention was installed, defrosting took seven or eight minutes, with no substantial temperature rise [I. 181-182] or necessity for removing the butter.

The District Court asked counsel for York Corporation to locate a brine spray defrosting unit in Los Angeles so that the court might inspect it. However, so thoroughly has the McAdam invention supplanted this salt brine method that counsel was unable to locate such a unit and advised the court that none existed in Los Angeles [I. 233].

The art had simply failed to realize that by making the system entirely "self-draining" this expensive salt could be eliminated.

While in retrospect the invention may now appear to be simple, this is evidence of the presence of patentable invention rather than being a bar thereto. While it may be wondered why such a simple, facile and efficient but economical method of defrosting the coils of low-temperature units was not earlier provided, the fact is the evidence shows that the art was struggling along with cumbersome, costly, and often dangerous expedients, such as reversing the cycle of the refrigerant gases, the so-called hot gas method, or providing complicated electrical



heating elements, or providing oversized units which could be shut off long enough to defrost themselves, and the like. The McAdam invention, even if simple, was certainly long overlooked.

What was said of the Grant tire patent by the Supreme Court in *Diamond Rubber Company of New York v. Consolidated Rubber Tire Company*, 220 U. S. 428 at 435, is applicable here:

“\* \* \* Many things, and the patent law abounds in illustrations, seem obvious after they have been done, and ‘in the light of the accomplished result,’ it is often a matter of wonder how they so long ‘eluded the search of the discoverer and set at defiance the speculations of inventive genius.’ *Pearl v. Ocean Mills*, 2 Bann. & Ard. 469, Fed. Cas. No. 10,876, 11 Off. Gaz. 2. Knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world was always ready at hand and easy to be seen by a merely skilful attention. But the law has other tests of the invention than subtle conjectures of what might have been seen and yet was not. It regards a change as evidence of novelty, the acceptance and utility of change as a further evidence, even as demonstration. \* \* \*”

As said by the Court of Appeals, Seventh Circuit, in *Pyle Nat. Co. v. Lewin*, 92 F. (2d) 628, at 630:

“It is also insisted that the idea involved in appellee’s device is so simple and obvious it does not constitute invention. True, it now has that appear-

ance. The fact, however, that this improvement was long overlooked, using devices far less satisfactory, cannot be ignored. As was said in *Expanded Metal Company v. Bradford*, 214 U. S. 366, on page 381, 29 S. Ct. 652, 656, 53 L. Ed. 1034: 'It may be safely said that if those skilled in the mechanical arts are working in a given field, and have failed, after repeated efforts, to discover a certain new and useful improvement, that he who first makes the discovery has done more than make the obvious improvement which would suggest itself to a mechanic skilled in the art, and is entitled to protection as an inventor.' "

*Aronson v. Toy Devices, Inc.*, 1 F. (2d) 91, at 92 (C. C. A. 3):

"\* \* \* Mere simplification of a substantial character, disposing of parts which have long been in use, may amount to invention. 'To obtain simplicity is the highest trait of genius.' *Hobbs Manufacturing Co. v. Gooding et al.*, 111 Fed. 403, 406, \* \* \*."

*James P. Marsh Corp. v. United States Gauge Co.*, 129 F. (2d) 161, at 163 (C. C. A. 7):

"\* \* \* Presumptuous indeed are the judicial pronouncements which are written in overconfident condemnation of seemingly simple, novel combinations."

See also:

*Young Radiator Co. v. Modine Mfg. Co.*, 55 F. (2d) 545 (C. C. A. 7);

*Potts v. Creager*, 155 U. S. 596, 608.

Ia.

The McAdam Invention Filled a Long-Felt Want in the Refrigerating Art.

The evidence shows that the refrigerating art had long been struggling with a problem of satisfactorily defrosting the coils of low-temperature refrigerating units; that prior to the McAdam invention no satisfactory solution to this problem had been made. Defrosting was a serious problem [III. 898].

In the article "Methods of Defrosting Various Types of Hardening Room Coils" by John C. Consley, Engineering Division, York Ice Machinery Corporation, published in the *September 1934* (four years before McAdam's invention came on the market) issue of "The Ice Cream Review," one of York Corporation's own employees [I. 121] offered to the trade a publication which stressed the duty of the engineers to maintain the highest efficiency of refrigerating units by proper defrosting. This report concluded:

"\* \* \* Defrosting is best accomplished in most instances by the hot gas method, \* \* \*." [IV. 1480.]

It is significant that while this report offers five methods for defrosting such coils, one of which methods had three subtypes, no mention of water defrosting using simple tap water was suggested. Indeed, the author does suggest using hot water or steam, but states:

"\* \* \* This method is seldom used, except in very small plants.

"The objections to this method are: (1) It is a rather sloppy practice: (2) it is slow, unless there is a large amount of hot water or steam available: (3) the very rapid and very great change in tem-

perature is somewhat dangerous to the coil and concrete floor: (4) much insulation has been ruined by this method: (5) the coil should be pumped out and liquid stored elsewhere before defrosting, otherwise there is a danger of excess pressure due to high temperature of ammonia in the coils. If the compressor is kept in operation, to avoid excess pressures, there is danger of the liquid slopping over in great quantities." [IV. 1477.]

The evidence shows that defrosting coils (even in rooms maintained 52° below the freezing point of water) is very quickly and very economically produced by the McAdam invention [I. 181-2]. The McAdam invention clearly filled a long-felt want in the art which was resorting to such tedious and impractical expedients as:

(1) Mechanically scraping or cutting off the ice, "a tedious process" [IV. 1476];

(2) Blasting the coils with hot air from high pressure hoses [IV. 1477];

(3) The brine method, of which the author states:

"This system is costly, since the brine is weakened by the amount of frost that is removed, and either must be reclaimed, or new brine made for each defrosting. It is also generally objectionable in ice cream plant hardening rooms, being sloppy, and requiring pans to catch the brine dripping from the coils." [IV. 1477; see *ante* pp. 15-16.]

(4) The hot water or steam method discussed above [IV. 1477]; and

(5) The hot gas method in which a hot gas from the compressor is run in the coils to heat the coils

rather than a cool gas from the condenser. An examination of pp. 1477-1479 of the transcript will indicate the amount of manipulation of the units required to utilize this method of defrosting, the problems involved and the special equipment necessitated.

Again in the article "Defrosting: A Survey of All Methods and Systems" by Siegfried Ruppricht (read at the June 1936 meeting of the American Society of Refrigeration Engineers, published in the magazine "Refrigeration Engineering," and purported to be an all-inclusive survey of the defrosting art as it stood at that time), we find the same long unfilled want. The author here again lists mechanically scraping off the ice [par. 1, IV. 1512]; a method of building up the pressure and suddenly releasing it, which is said to blast the frost away [par. 2, IV. 1512]; coating the exposed surfaces with rubber to which ice will not stick [par. 3, IV. 1512]; salt brine spray [par. 4, IV. 1512]; the salt tray method in which trays of salt are placed adjacent the evaporator coils to form a brine [par. 5, IV. 1512]; various chemical methods [par. 6, IV. 1512]; the use of two refrigerating units, each alternately, one defrosting while the other operates [par. 8, IV. 1512]; shutting off the refrigeration in small installations where heat is present sufficient to melt the frost [par. 9, IV. 1512-13]; electrical heating [pars. 10, 11, 12, IV. 1513]; hot brine within the coils [par. 13, IV. 1513]; hot air blast [par. 14, IV. 1513]; passing into the coils warm unexpanded gas [pars. 15 and 16, IV. 1513-14]; the reverse cycle or hot gas method

[par. 17, IV. 1514]. The only mention made which might approach water defrosting as described in the McAdam patent is the statement:

“7. In emergency cases, service men pour water over thickly frosted coils, as is customary with metallic ice-cube trays, and *this method could be employed in a permanent installation were it not for the trouble caused by water freezing in the piping during regular operation.*” [Emphasis supplied; par. 7, IV. 1512.]

Self-drainage cannot have been obvious to this expert in this art. Without self-drainage the McAdam apparatus would likewise be inoperative. With self-drainage continuous operation of the plant was possible with the freezing element located within a space continuously maintained below the freezing point of water.

This problem and the long felt want is evidenced by the manual published by defendant York Corporation [Defts. Ex. R, IV. 1498]. This manual, dated February 1, 1936, states that the York Corporation was using the hot gas method of defrosting while warning that in below-freezing installations a drain line for the melted frost could not be used as it would become frozen shut.

The McAdam invention is thus proven to have supplied a long-felt want and solved a critical problem in the refrigeration art. The Supreme Court has recognized that these facts:

“\* \* \* should, in a close case, tip the scales in favor of patentability. \* \* \*” (*Goodyear Tire & Rubber Company, Inc., v. Ray-O-Vac Company*, 321 U. S. 275, 279 (1944) (citing numerous cases).)

“\* \* \* This, of itself, is persuasive evidence of that invention which it is the purpose of the patent laws to reward and protect. \* \* \*” (*Minerals Separation v. Hyde*, 242 U. S. 261, 270.)

The reason for this test of invention is stated in *Paramount Publix Corporation v. American Tri-Ergon Corporation*, 294 U. S. 464, 474:

“\* \* \* Where the method or device satisfies an old and recognized want, invention is to be inferred, rather than the exercise of mechanical skill. For mere skill of the art would normally have been called into action by the generally known want.”

See also:

*Iron Fireman Mfg. Co. v. Industrial Engineering Corp.*, 89 F. (2d) 904, at 909 (C. C. A. 7);

*Delta Mfg. Co. v. E. L. Essley Machinery Co.*, 153 F. (2d) 905, at 906 (C. C. A. 7);

*Forestek Plating & Mfg. Co. v. Knapp Monarch Co.*, 106 F. (2d) 554 (C. C. A. 6);

*Tyra v. Adler*, 85 F. (2d) 548 (C. C. A. 8).

#### Ib.

**The Refrigeration Art Was Sceptical of and Ridiculed the McAdam Invention. Even After Appellee Introduced This Invention the Art Refused to Accept It Until Its Success Was Proven by Use.**

It was necessary for Refrigeration Engineering, Inc., to overcome an initial scepticism on the part of the refrigeration industry in order to obtain adoption of the McAdam invention.

It cannot be said that it was obvious to introduce water into a space which may be perhaps 52° below the freezing point of water in the hope of removing frozen water.



There is indeed an element of daring in the suggestion. This is completely demonstrated by the fact that the refrigeration industry originally scoffed at the McAdam invention and refused to accept it, going so far as to require guarantees of complete satisfaction from Refrigeration Engineering, Inc., under which guarantees Refrigeration Engineering, Inc., was forced to undertake to remove the McAdam water defrosting units and replace them with conventional units in the event that they were not completely satisfactory.

The District Court found:

“9. That upon introduction of the invention of the patent in suit to the art, the engineers in the art did not believe that the device of the McAdam patent in suit would function to defrost coils within a refrigerated space maintained below the freezing point of water and it was necessary for defendant corporation to give guarantees of satisfaction in order to make installations of devices embodying the invention of the Letters Patent in suit.” [Finding 9, I. 15.]

This finding is amply supported by the evidence. [I. 59, 70-71; Ex. D, IV. 1484; I. 124, 153-4, 156.]

Qualified refrigeration experts doubted the practicability of the McAdam invention, even after it had been demonstrated [I. 57; I. 152-3]; when an attempt was made to interest the York Corporation in the McAdam invention the York experts in Los Angeles deemed the invention unsound [I. 194, 197], declaring that it was an exploded idea which would not work [I. 240, 241].



Ic.

Having Been Proven Practical and Efficient, the McAdam Invention Went into Widespread Commercial Use.

The evidence shows that after the feasibility of the McAdam invention was demonstrated to the trade, particularly by the Johnson Pie installation in Los Angeles [I. 235-9] and the Haslett Warehouse installation in Oakland [I. 157-185], the invention went into widespread commercial use. The success of Refrigeration Engineering Inc.'s business is largely due to McAdam's invention [III. 1093]. It has progressed since 1938 from a net worth of \$57,000 to a net worth of \$250,000, its sales correspondingly rising from \$200,000 a year to \$1,000,000 per year [III. 1093]. Its success was achieved with substantially no advertising [III. 1092]. The licensees of Refrigeration Engineering, Inc., under the McAdam patent, had paid to the end of 1945 royalties in the sum of \$52,345.75. Further, some 50,000 water defrost refrigeration units were built for the armed services during the war [I. 189; Finding 15, I. 16]. This remarkable commercial success, together with the compliment of infringement which has been paid to the McAdam invention by the York Corporation by embodying water defrosting in 11% of its sales, exclusive of sales to the armed services [III. 1032, 1045-6], is further demonstration of the fact that McAdam's contribution to

the art involved patentable invention. As said by the Supreme Court in *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U. S. 45, 56:

“The fact that the Eibel pitch has thus been generally adopted in the paper-making business, and that the daily product in paper making has thus been increased at least 20 per cent over that which had been achieved before Eibel, is very weighty evidence to sustain the presumption from his patent that what he discovered and invented was new and useful. \* \* \*”

Further, as said by the court in *Wahl Clipper Corp. v. Andis Clipper Co.*, 66 F. (2d) 162 at 165 (C. C. A. 7):

“\* \* \* More persuasive evidence than the action of competitors in taking licenses and paying substantial royalties for the privilege of selling the patented article can hardly be found.”

Further, York Corporation's slavish imitation of the McAdam patent is itself very strong evidence of invention:

“The imitation of a thing patented by a defendant, who denies invention, has often been regarded, perhaps especially in this circuit, as conclusive evidence of what the defendant thinks of the patent, and persuasive of what the rest of the world ought to think. \* \* \*” (*Kurtz v. Belle Hat Lining Co.*, 280 Fed. 277, at 281.)

“\* \* \* The prior art was open to the rubber company. That ‘art was crowded,’ it says, ‘with numerous prototypes and predecessors’ of the Grant tire,

and they, it is insisted, possessed all of the qualities which the dreams of experts attributed to the Grant tire. And yet the rubber company uses the Grant tire. It gives the tribute of its praise to the prior art; it gives the Grant tire the tribute of its imitation, as others have done. And yet the narrowness of the claims seemed to make legal evasion easy. Why, then, was there not evasion by a variation of the details of the patented arrangement? Business interests urged to it as much as to infringement. We can find no answer except that given by the tire company: 'The patented organization must be one that is essential. Its use in the precise form described and shown in the patent must be inevitably necessary.' " (*Diamond Rubber Company of New York v. Consolidated Rubber Tire Company*, 220 U. S. 428, 441.)

In such a case we may ask the same question of the York Corporation as was asked by the court in *Wahl Clipper Corp. v. Andis Clipper Co.*, 66 F. (2d) 162 at 165 (C. C. A. 7):

"\* \* \* In explaining its action in thus changing its vibrator, appellee (Andis Company) argues that it was within its legal rights in so acting. Conceding for the moment its legal rights, the question exists, Why change its type of vibrator unless the article copied possessed merit? And why was not the change made earlier if the article possessed merit and its production was obvious to a mechanic skilled in the art?"

## II.

**The District Court Properly Concluded That the Mc-Adam Patent Was Novel, Useful, and Not Anticipated by Anything Existing in the Prior Art [Finding of Fact 19, I. 17].**

### IIa.

**The Patent in Suit Is Not Anticipated by the Gayley Dry Blast Installations.**

The York Corporation took depositions in an attempt to establish an alleged prior use of water defrosting in the so-called Gayley dry blast installations. These installations were mammoth structures designed to cool the air feed to a blast furnace in order to regulate the amount of moisture therein. Concerning them, the District Court found that in these installations the pipes for spraying the water over the coils were not self-draining, but were horizontally disposed, as were pipes leading to and from the chamber containing the coils [Finding 21, I. 17]. Further, the District Court found that during the period of defrosting the chambers containing the coils were above the freezing point of water [Finding 22, I. 17] and that during defrosting the refrigerant was withdrawn from the coils and the temperature of the refrigerant so withdrawn was above the freezing point of water [Finding 23, I. 17]. Further, the court found that the time element during defrosting was such that the space containing the coils was above the freezing point of water and, hence, the Gayley dry blast process did not provide a refrigerating coil positioned within a refrigerating space constantly below the freezing point of water [Findings 24 and 25, I. 17-18]. These findings are amply supported by the evidence.

The determining factor with respect to these so-called “Gayley Dry Blast Installations” is that they were not “self-draining” and were not located in a space constantly maintained below the freezing point of water, especially during the defrosting operation.

The first sentence of the McAdam patent in suit states: “My invention relates to low temperature refrigeration where a space is required to be constantly maintained at temperatures below the freezing point of water, \* \* \*.” Claim 13 (held to be valid and infringed) calls for “\* \* \* the air of said space does not rise above the freezing point of water during the defrosting period, \* \* \* .” [IV. 1432, col. 2, lines 44-5.] Clearly the McAdam invention is not anticipated by a refrigerating apparatus which is not maintained *constantly* below the freezing point of water; particularly is this true where the operation of the alleged anticipating device was based upon permitting it to warm up during the crucial period—the defrosting period.

Further, the McAdam patent requires both the supply line and drain line to be “self-draining.” Self-draining is essential to the success and to the mode of operation of McAdam’s apparatus. Clearly the McAdam patent is not anticipated by an installation which was neither self-draining nor located in a space constantly maintained below the freezing point of water.

The District Court’s findings of fact [19, 21-27] are in accordance with the overwhelming weight of the evidence. The evidence shows that each of the three “Gayley Dry Blast” installations consisted of large buildings divided into a number of separate compartments, each containing separate brine coils for cooling a stream of air and each operated independently of the others [Brandt, I. 315-

316; Kennedy, I. 363; Tominac, II. 507; Mueller, II. 579, 594]. Thus there were four separate compartments at the Isabella Furnaces, seven at Illinois Steel South Chicago Works and, again, four at Mayville.

These compartments were defrosted, one by one, at the rate of one per day. In each case the first step was to close off the particular compartment to be defrosted from the others and the stream of air by closing doors or shutters, both leading in and leading out of the chosen compartment [Brandt, I. 318, 327-8; Kennedy, I. 363; Harkins, II. 386; Tominac, II. 508; Mueller, II. 596]. Concurrently the refrigerating brine was drained out of the brine coils. This brine was pumped completely out of the compartment [Brandt, I. 318-9; Kennedy, I. 364; Harkins, II. 386; Tominac, II. 508; Mueller, II. 580, 597]. This, of course, permitted the chosen compartment to begin immediately to warm up. There was no further refrigerant being supplied and, in fact, outside air was vented into the coils [II. 596]. At least the lower portion of the coils never was reduced below approximately 35° F. or several degrees above freezing, as the refrigerating brine itself came out at that temperature [Tominac, II. 532; Mueller, II. 615]. This is further shown by the fact that at least the lower one-third and probably the lower two-thirds of the coils never reached freezing as they were constantly dripping wet [II. 614].

Further, in each case the time element involved was of such duration, even before the coils were sprayed with water, as to insure that the compartment during the spraying would be well above freezing. The total defrosting time was several hours [Brandt, 1½ to 1¾ or more hours, I. 319, 341; Tominac, 3½ to 5½ hours, II. 509; Mueller, 3 to 5 hours, II. 619; 11 to 12 hours, II. 621],



and in each case a substantial period of time elapsed between the shutting down and closing off of the chosen compartment and the turning on of the water spray [Brandt, I. 318-9; Tominac, II. 510; Mueller, II. 596-7].

While there was an attempt to prove that these units reached freezing temperatures during operating periods, not one witness testified to the temperature in the compartments during the defrosting periods. The closest that any of York Corporation's or any other witness came was when the witness Kennedy testified that the compartment was below freezing "when you *started* to defrost" [I. 365; emphasis ours].

Further, the physical construction of these plants precluded them from being "constantly maintained at temperatures below the freezing point of water," because the water pipes within the compartments were horizontally positioned, preventing self-draining and assuring that they would become clogged with ice if constantly maintained at a temperature below freezing. An examination of the exhibits offered to prove the structure of these installations shows in each case a horizontal header and horizontal laterals which could not be "self-draining."

The Isabella Furnaces dry blast installation is said to be depicted in plaintiff's Ex. 1 [IV. 1117]. The court will note that the pipe entitled "water spray pipe" appearing near the top of the left-hand figure of this drawing is perfectly horizontal. Further, this pipe runs to another horizontal pipe entitled "6" water header" adjacent the left-hand upper corner of the figure and the bottom of this pipe is below the bottom of the horizontal pipe leading from it through the wall of the building to the pipe labeled "6" pipe" (farthest pipe to left in drawing), which is said to be the drain pipe.

Reference to the drawing of the Mayville plant, plaintiff's Ex. 7 [IV. 1125], shows a horizontal "water pipe for thawing" in the upper part of the left-hand figure, and again, reference to the drawing of the South Chicago Works of the Illinois Steel Company, plaintiff's Ex. 31 [IV. 1153], shows a horizontal water pipe, labeled K in the drawing, entitled "Brine Cooler Building" in the upper right corner as well as a horizontal water pipe, K, L, in the figure "Section A-A." This pipe is shown duplicated seven times in the figure directly above. Concerning these pipes the witness Tominac testified:

"XQ. 215. Now, this drainpipe that you say was over the coils, you say it was horizontal? A. Yes, sir.

XQ. 216. That is, perfectly flat? A. Yes, sir." [II. 530.]

These installations did not embody the McAdam mode of operation. They were not "self-draining" within the meaning of the McAdam patent in suit, and do not anticipate the McAdam invention. Claims 7, 8, 10, 11, 12 or 13 specifically call for the conduits to be "self-draining," and the remaining claims require this in other language.

Not being "self-draining" and not being designed for defrosting while being constantly maintained below the freezing point of water, these Gayley Dry Blast installations clearly have no effect on the validity of the McAdam patent. Besides not being directed at a solution of this problem solved by McAdam, they exhibit one of the objectionable features particularly desired to be overcome by the McAdam invention, *i. e.*, the necessity of closing off and



isolating the refrigerating unit during defrosting. Concerning this the McAdam patent teaches [IV. 1429]:

“Another defrosting method for low temperature work is to provide and periodically operate a system of doors or dampers around the coil which act to temporarily isolate the coil from low temperature air and bring it in contact with a flow of extraneous warm air. This requires locating the coil near one wall of the refrigerated compartment and is also slow and tedious by reason of the low rate of heat transfer from air to ice. Also this method finally brings the coil or heat transfer surfaces to many degrees above freezing, and unless warm air continues to move over the surfaces until they are quite dry the coil will give off warm humid air when again brought into contact with the cold air of the refrigerated space.”

Neither of the alleged dry blast installations contains the combination of devices claimed in the McAdam patent as constituting the patented invention, let alone a combination performing the same functions in the same way. Neither of them contains McAdam's features of novelty. Therefore neither anticipates McAdam's invention. (*Cf. Paraffine Companies, Inc., v. McEverlast, Inc.*, 84 F. (2d) 335 at 339 (C. C. A. 9).)

Failing to disclose each element of a combination comparable to McAdam's combination (functioning in the same way to produce the same results) or failing to solve the problem solved by McAdam, they cannot anticipate McAdam. (*Lincoln Stores, Inc., v. Nashua Mfg. Co.*, 157 F. (2d) 154, 160 (C. C. A. 1) (1946).)

IIb.

The Patent in Suit Is Not Anticipated by the Polar Ice Co.  
Installation at Indianapolis.

This installation was a storage plant of Polar Ice & Fuel Co. designed to house a coin operated ice dispensing machine. Sometime in 1934 it was installed and leased to the witness Martin. Concerning this installation the District Court found [I. 18-19]:

“28. That the installation known as the ‘Polar Ice installation’ and concerning which the depositions were taken in Indianapolis, Indiana, does not anticipate the Letters Patent in suit and does not disclose the invention thereof.

“29. That the installation, the subject matter of the depositions taken in Indianapolis and referred to as the ‘Polar Ice installation’ was not so constructed as to provide for self-draining of the water but, on the contrary, it was established that the pipes were so installed as to prevent self-draining.

“30. That the installation, the subject matter of the depositions taken in Indianapolis and referred to as the ‘Polar Ice installation’ was not used, nor was it adapted for use, within a refrigerated space maintained below the freezing point of water.

“31. The installation, the subject matter of the depositions taken in Indianapolis and referred to as the ‘Polar Ice installation’ was discarded and abandoned and no other like system was ever installed or used by those interested in or instrumental in its construction and attempted use.

“32. The depositions taken at Indianapolis concerning the ‘Polar Ice installation’ do not establish prior invention, manufacture, use or sale of a water

defrosting system anticipating the invention of the McAdam patent in suit."

These findings are in accord with the overwhelming weight of the evidence.

The evidence is conflicting as to whether this unit was ever operated at below freezing. Martin testified for York Corporation but was not asked concerning this [II. 501-2]. From April, 1936, to the date of his deposition York's witness Simons leased the premises. He testified that the temperature maintained was 33° F. [II. 490, 492]; that he always stored soft drinks such as Coca-Cola in the room [II. 490, 491]; had stored milk there for four years [II. 490]; that this milk never froze [II. 492].

York's witness, Barton, testified that the photograph, Ex. 18 [IV. 1135], correctly shows the original installation [II. 418]. Referring to this exhibit, he states:

"Q. Do you note any other change that was made in this installation? A. I see no other changes from the original installation. That statement was that this entire installation was indelibly imprinted on my mind due to this being such a headache and a source of so much trouble." [II. 418.]

He also states that the item marked "Y" in Ex. 18 is a water cooler [II. 419]. From the photograph this water cooler is directly under the cold diffuser. This substantiates the testimony of the witness Simons that this room was not operated at below freezing temperatures.

Some of the testimony relates to a necessity for maintaining the room below freezing in order to prevent the blocks of ice from freezing together, but this is refuted by the fact that at 33° F. the witness Simons experienced no such trouble [II. 490].

In the photographs, Exs. 18 and 19 [IV. 1135-1136], the room exhibits great evidence of the wooden walls deteriorating from wet rot [indicated at A-A in Ex. 18 and at W and Z in Ex. 19 [*cf.* Simons' testimony, II. 491]]. Wet rot would not occur in a room maintained below freezing. It was evident when Simons took over in April, 1936, and has become progressively worse ever since [II. 491, 496].

The unit was not self-draining. Inspection of the photograph [Ex. 18, IV. 1135] shows that if the section R-S of pipe A (the water supply pipe) is not slanted downwardly as it progresses from R to S, it is at least horizontal, if not inclined upwardly from S-R. Simons was positive that point L of the waste pipe B was above point M [II. 492, 495]. Further, Simons found that when he tried to water defrost, water stuck in the line at the top of the coil unit. This would indicate that it was not "self-draining" [II. 495].

The most that York Corporation can claim is that there is a conflict in the evidence. Furthermore, even those witnesses who seemed most eager to establish this alleged prior use refused to be positive. For example, the witness Barton stated his testimony could not be conclusive as to maintaining below freezing conditions in the room [II. 431]; the witness Hayes refused to state whether or not the supply and drain lines were so inclined as to be self-draining [II. 457-9].

It is submitted that the overwhelming weight of the evidence is in support of the findings of the District Court. It cannot be disputed that these findings are supported by substantial evidence—every bit of it educed on cross-examination from witnesses testifying for York Corporation. Moreover, it is to be kept in mind that a

very heavy burden of proof rested upon York Corporation to sustain such a defense.

As said by this Court in *Paraffine Companies, Inc., v. McEverlast, Inc.*, 84 F. (2d) 335, at 339 (C. C. A. 9):

“The burden of proof on the issue of prior public use rests heavily upon the party seeking to show such use. Of such a defense the Supreme Court has said: ‘Courts have not only imposed upon defendants the burden of proving such devices, but have required that the proof shall be clear, satisfactory, and beyond a reasonable doubt.’ *Washburn etc. Co. v. Beat 'Em All Barbed Wire Co.*, 143 U. S. 275, 284, 12 S. Ct. 443, 447, 36 L. Ed. 154.

“To the same effect are *Deering v. Winona Harvester Works*, 155 U. S. 286, 300, 301, 15 S. Ct. 118, 39 L. Ed. 153; *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U. S. 45, 60, 43 S. Ct. 322, 67 L. Ed. 523; *Rown v. Brake Testing Equip. Corp.* (C. C. A. 9), 38 F. (2d) 220, 223. The rule has been recently restated, perhaps modified, in *Radio Corp. v. Radio Engineering Laboratories*, 293 U. S. 1, 7, 55 S. Ct. 928, 931, 79 L. Ed. 163, where the Supreme Court, speaking through Mr. Justice Cardozo, said: ‘Sometimes it is said that in a suit for infringement, when the defense is a prior invention, “the burden of proof to make good this defense” is “upon the party setting it up,” and “every reasonable doubt should be resolved against him.” (Citing cases.) Again it is said that “the presumption of the validity of the patent is such that the defense of invention by another must be established by the clearest proof—perhaps beyond reasonable doubt.” (Citation.) The context suggests that in these and like phrases the courts were not defining a standard in terms of scientific accuracy or literal precision, but

were offering counsel and suggestions to guide the course of judgment. Through all the verbal variances, however, there runs this common core of thought and truth, that one otherwise an infringer who assails the validity of a patent fair upon its face bears a heavy burden of persuasion, and fails unless his evidence has more than a dubious preponderance.' ”

Finally, to bolster this alleged Polar Ice & Fuel Co. prior use, evidence was introduced by York Corporation concerning certain correspondence between patent attorneys Goldsmith and Galt and their client Joe Hayes (who did not testify). Concerning this it is sufficient to point out that the entire matter died with the patent attorney's report [Ex. 27, IV. 1127] suggesting the filing of a patent application. An abandoned application, as such, is no anticipation.

*The Corn Planter Patent (Brown v. Guild)*, 23 Wall. (90 U. S.) 181, 211;

*Monarch Marking System Co. v. Dennison Mfg. Co.*, 92 F. (2d) 90 (C. C. A. 6);

*Interurban Ry. & Terminal Co. v. Westinghouse Electric & Mfg. Co.*, 186 Fed. 166 (C. C. A. 6).

## IIc.

### The Patent in Suit Is Not Anticipated by the Swift & Company Installation at Elmira.

There were three installations in the Swift & Company plant at Elmira, New York, concerning which testimony was offered. Two of these installations, the sausage room and the pickle room, were equipped to defrost by spraying water over the coils, but were not designed for nor operated at temperatures below the freezing point of water



[III. 644; Smith, II. 668, 670; Fuller, II. 682]. The third room was a below freezing room but admittedly used a different type of defrosting system.

Concerning these installations, the District Court [I. 19-20] found:

“33. The depositions taken at Elmira, New York, concerning the Swift & Company installation do not establish prior manufacture, use, sale or knowledge of the invention of the McAdam Patent No. 2,219,393 in suit.

“34. The depositions taken at Elmira, New York, concerning the Swift & Company installation do not establish the use of a system of water defrosting in a refrigerated space maintained below the freezing point of water.

“35. The depositions taken at Elmira, New York, concerning the Swift & Company installation do not establish that the system was self-draining but, on the contrary, establish that the system as installed and used was not self-draining.

“36. That the depositions taken at Elmira, New York, concerning the Swift & Company installation established that Swift & Company operated a below freezing storage room for holding meat at temperatures below the freezing point of water and that in connection with such installation, Swift & Company did not use the system of water defrosting as disclosed in the McAdam patent in suit, but utilized a different system of defrosting refrigerating coils within the room which required removing all frozen products from the room permitting temperature of the room to rise above the freezing point of water during defrosting.”

These findings are in accord with the overwhelming weight of the evidence.

It is not even contended by York Corporation that the pickle room or the sausage room (the rooms employing water defrosting) were operated at temperatures below freezing [Statement of Counsel, II. 644], but merely that *accidentally* they might go below freezing. Apparently the pickle room did freeze at least once, but what happened? The spray pipe froze up [II. 685] and split [II. 684-5].

While York Corporation did contend that these two suits were self-draining, the accident to the pickle room spray pipe negatives this. Also, the actual physical condition of the pipes disproves it. Thus the witness Smith testified that the water inlet pipes on both units slanted downwardly so that water would be trapped in the pipes between the valves and the water main within the room [see Ex. 38, IV. 1206; Ex. 39, IV. 1207; Ex. 41, IV. 1209; and II. 673].

Further, the witness Van Patten, who held the contract for installing the piping, identified an ordinary gate valve (without such a vent as would be necessary to drain any part of the lines) as the type valve originally installed [II. 697].

Certainly if Swift & Company discovered that these rooms could be operated at a temperature below freezing by making the supply and drain lines self-draining, they would have applied this system to their cold room. But the evidence shows that in that room, which was maintained below freezing, they first removed all of the meat from the room, allowed the temperature to rise and then, in order to defrost, sprayed water from a hose. This



room was then cooled again before returning the meat [II. 675]. No explanation is offered as to why this cumbersome practice was followed under such circumstances. These evidentiary facts fully support the District Court's ultimate finding that neither of these installations discloses the McAdam invention [Finding 33, I. 19].

## IIId.

### The Patent in Suit Is Not Anticipated by the Abandoned Experiment at Yamhill, Oregon.

Much evidence was offered, both by deposition and by witnesses testifying in open court, respecting a purported prior use at Yamhill, Oregon. This related to the installation in the Trullinger and Eustice store in that city of a locker room and chill room using a Carrier 15 Q-2 diffuser. There is no conflict in the evidence on the point that as originally planned and installed this unit employed the reverse-cycle hot gas method of defrosting, or that as finally operated, it employed the "hot air" method of defrosting. The conflict is with respect to what was employed in the intervening period.

Testimony was offered by York Corporation in the attempt to prove that for a period of time between these two methods, a water defrosting method was employed.

Concerning this, the District Court found [I. 20-22]:

"37. In the depositions taken at Portland, Oregon, and concerning which installation the witness W. C. Hulse, testified before this Court, and referred to as the 'Yamhill installation,' it is not established that said installation was either made, used or sold, or that those taking part in the said installation or use had knowledge of the invention of the McAdam patent in suit No. 2,219,393.

“38. It is established that the said ‘Yamhill installation’ was an abandoned experiment which was never repeated, no like installation was ever made by those interested in this attempted use and did not teach the art the system of water defrost as set forth in the McAdam Patent No. 2,219,393.

“39. In conjunction with the refrigeration machinery installed at Yamhill, Oregon, several different methods of defrosting were attempted unsuccessfully and later abandoned, with the result that the system now utilized at Yamhill, Oregon, was the older system of hot air defrosting requiring the blowing of air over the coils to melt the frost therefrom, which results in a rise in temperature of the refrigerated space.

“40. In conjunction with the different methods of defrosting attempted to be used at Yamhill, Oregon, it is established that during attempts to utilize water for defrosting the refrigerating coils were positioned outside of the refrigerated space.

“41. In conjunction with the several different methods of defrosting which were attempted to be used at Yamhill, Oregon, it is not established that the temperature within the space in which the refrigerating means were operated was maintained below the freezing point of water.

“42. In conjunction with the Yamhill installation, it is established that the attempt to use water for the purpose of defrosting was unsatisfactory.

“43. It is established that the refrigeration machinery installed at Yamhill, Oregon, was not paid for by the owners thereof, Eustice and Trullinger, during the attempt to utilize water for the purpose of defrosting.

“44. While water was attempted to be used at the Yamhill, Oregon, installation, it is established that the refrigerated coils were isolated from the refrigerated space of the Eustice and Trullinger locker room during attempts to defrost the coils thereof by closing doors over the inlet and outlet to the coil containing space with the result that the temperature within the coil housing was not maintained below freezing during defrosting.

“45. In conjunction with the Yamhill installation, it is established that the attempt made to utilize water for defrosting of this system was forgotten by those interested in the installation, that a similar installation was never made at any other place, although the witnesses who testified concerning this attempted installation testified that the problem of defrosting still remained acute after such installation was discontinued.

“46. In conjunction with the Yamhill installation, it is not established when the attempt was made to utilize water for defrosting or when the attempt was discontinued, but it appears that the records of both of these facts were in possession of plaintiff’s witnesses and were not produced by plaintiff.

“47. In conjunction with the Yamhill installation, the Court finds that the witness, W. C. Hulse’s testimony was not worthy of belief and the Court observed his manner and demeanor while giving his testimony before the Court, and his testimony was found to be impeached upon material grounds.”

These findings are fully supported by the evidence. Especially is this true in view of the heavy burden of proof upon York Corporation to establish such an alleged prior use. (*Paraffine Companies, Inc. v. McEverlast, Inc.*, see *ante*, pp. 37-38.)

The testimony of the witnesses called by York Corporation, is hopelessly confused. Witnesses testified that at some unascertained time the hot-gas method of defrosting was purportedly removed and a water defrosting system substituted. This water defrosting unit was supposedly originally in the "chill room," a room maintained at 35-38° F., well above the freezing point of water [Broms, II. 735; Postlewaite, III. 879; and see Proposal Ex. Y-1, IV. 1216]; at some unascertained time an insulated wall was built around it to isolate it from the chill room [Trullinger, III. 770, 782-3; Postlewaite, III. 879; Hulse, III. 938; Ex. Y-28, IV. 1241]. Still later, at another unascertained time, the unit was moved from the chill room and placed in the locker room, and the hot-air method of defrosting substituted [Trullinger, III. 772, 778; Eustice, III. 845]. The evidence of when this alleged changeover to hot air was made was in the possession of the witness Trullinger, but no explanation of the failure to offer it is made [III. 795].\* The unit was admittedly unsatisfactory at least two separate times in its state of development and payment therefor refused by the purchasers [Broms, II. 708; Trullinger, III. 759, 770, 782-3; Eustice, III. 845, 850; Postlewaite, III. 894]. There is no clear-cut evidence that the unit was ever paid for, even subsequent to the changeover to hot-air defrosting [III. 767, 787].

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\*\*\* \* \* it has always been the law that where knowledge and means of proof with respect to an issue are peculiarly within the power and control of one of the parties, the burden of proof is, to that extent, placed upon him, although it would otherwise rest upon his adversary." (*Kalo Inoculant Co. v. Funk Bros. Seed Co.*, 161 F. (2d) 981, at 989 (C. C. A. 7) (citing cases).)

At least two witnesses unqualifiedly state that the unit was always unsatisfactory. Eustice admitted this [III. 845, 850]. They couldn't make it work [Postlewaite, III. 894]. And the man in charge of the company who installed the unit stated that even when it seemed to have cleaned off the top of the coils, there would be large blocks of heavy, glazed ice on the lower side [III. 1077]. His company lost money on the job, due to continuous service charges caused by defrosting problems [III. 1075-6].

There is no dispute about the fact that the alleged water defrosting was torn out and none of those associated with it ever attempted to build another unit like it. [Broms, II. 738; Hulse, III. 965; Dahl, III. 1078.]

The evidence further shows that this Yamhill installation not only was an unsuccessful, abandoned experiment, as the District Court was impelled to find from the evidence, but did not embody the McAdam invention.

While the unit was in the chill room it was not within a refrigerated space constantly maintained below the freezing point of water [II. 735, III. 879, IV. 1216]. The witness Postlewaite unequivocally testified to the fact that prior to enclosing the unit with insulating walls, it was above freezing during defrosting [III. 892]. Like the Elmira installation heretofore discussed, such installation did not involve the problem solved by the McAdam invention, and cannot anticipate it.

The evidence of what was done when an insulated wall was built around the unit to shield it from the chill room is again hopelessly confused. The witness Broms recalls no doors or vanes for shutting this enclosure off from the cold room; *i. e.*, the locker room, but won't say there were none [II. 735]. The witness Hulse says there was a vane

on the lower opening, the intake from the locker room, but none on the upper outlet [III. 945]. Postlewaite testified there was a door on each [III. 893], and Trullinger, who owned and operated it, testified that not only was there a door on each but during defrosting these doors were closed *to keep the cold from the locker room from coming in*, and that the water would freeze if you did not [III. 779-80, 797-8, 810]. In fact, Trullinger testified on cross-examination that you couldn't defrost the unit until it was enclosed [III. 782-3] and then later repudiated this [III. 820].

No witness testified to the temperature of the insulated compartment during defrosting. It was closed off from both the cold locker room and the 35° F. chill room and "the cold kept out."

The witness Hulse testified to ice being in this chamber [III. 937, 965-6], but he was thoroughly impeached and found not worthy of belief [Finding 47, I. 22]. The District Judge found it necessary to caution him to quit trying "to outfigure counsel and the court" [III. 968]. Two witnesses testified to a conversation (which Hulse denied having [III. 951-2]) wherein Hulse admitted this installation wouldn't work [III. 1065-7, 1071, 1095]. Further, Hulse's attempt to solicit the testimony of the witness Dahl to whom he stated "it meant considerable to him" indicated his bias [III. 1082-4].

If the court could accept the testimony of Trullinger and Postlewaite, there were doors to isolate the chamber from the cold room during defrosting. The doors were closed during defrosting to keep out the cold air from the locker room [III. 779-80, 797-8, 810], and the isolated unit was permitted to warm up during defrosting. In fact, if this were not done it would freeze [III. 797-8].



Therefore, it is clear that this unit was not, and could not be, maintained below freezing during defrosting. We have heretofore pointed out that one of the objects of the McAdam invention is to defrost at below freezing temperatures without the necessity of closing off and isolating the refrigerating unit during defrosting.

In summary, then, with respect to this alleged Yamhill prior use:

It was an unsatisfactory, unsuccessful experiment;

It was abandoned and never revived;

It was not constantly maintained below the freezing point of water and, hence, did not involve the McAdam invention; and

It involved walls and vanes isolating the refrigerating unit, a defect which it is one of the objects of the McAdam invention to avoid.

As pointed out, the District Court made detailed findings on each of these issues. Material to these findings was the testimony of the witness Hulse and the impeaching testimony of the witnesses Wilde, Dahl and Jarvis, all given in open court. On these issues RCP 52 is particularly applicable:

“\* \* \* Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. \* \* \*”

As said by this court in *Wittmayer v. United States*, 118 F. (2d) 808, 811 (C. C. A. 9):

“The findings of the trial court fall within the familiar rule, that where based upon conflicting evidence they are presumptively correct, and unless some



obvious error of law, or mistake of fact, has intervened, they will be permitted to stand. *Silver King Coalition Mines Co. v. Silver King C. M. Co.*, 8 Cir., 204 F. 166, 177, Ann. Cas. 1918B, 571.

“The provisions of the new procedural rules that the findings of fact of the trial judge are to be accepted on appeal unless clearly wrong (Rule 52(a), 28 U. S. C. A. following section 723c), is but the formulation of a rule long recognized and applied by courts of equity. *Guilford Const. Co. v. Biggs*, 4 Cir., 102 F. 2d 46, 47.

“As was said by Mr. Justice Holmes in *Adamson v. Gilliland*, 242 U. S. 350, 353, 37 S. Ct. 169, 170, 61 L. Ed. 356 (citing *Davis v. Schwartz*, 155 U. S. 631, 636, 15 S. Ct. 237, 39 L. Ed. 289), the case is pre-eminently one for the application of the practical rule, that so far as the findings of the trial judge who saw the witnesses ‘depends upon conflicting testimony or upon the credibility of witnesses, or so far as there is any testimony consistent with the finding it must be treated as unassailable.’ ”

See also:

*United States v. Protsch, et al.*, 137 F. (2d) 92 (C. C. A. 10);

*Gary Theatre Co. v. Columbia Pictures Corporation*, 120 F. (2d) 891 (C. C. A. 7).

The evidence before the court is clearly insufficient to establish that the McAdam invention is anticipated by this Yamhill installation.

Upon substantial evidence it was found to have been an unsuccessful, abandoned experiment.

This court has announced the applicable rule of law in *Consolidated Contract Co., et al., v. Hassam Paving Co., et al.*, 227 Fed. 436, at 441 (C. C. A. 9), wherein the court said:

“\* \* \* The experiment was not satisfactory, but, as the witness said, ‘demonstrated that I might have something of practical value, but that I had not carried it far enough, or experimented enough at length, to demonstrate its practical value.’ The pavement laid by McClintock was never used elsewhere or tried again. We agree with the learned judge of the court below that McClintock’s venture comes clearly within the category of an abandoned experiment, which is not sufficient in law to anticipate a successful patent. \* \* \*”

Again, as said by the Circuit Court of Appeals, Second Circuit, in the recent case of *Picard v. United Aircraft Corporation*, 128 F. (2d) 632, at 635:

“\* \* \* It is also true that another’s experiment, imperfect and never perfected, will not serve either as an anticipation or as part of the prior art, for it has not served to enrich it. The patented invention does not become ‘known’ by such a use or sale, or by anything of which the art cannot take hold and make use as it stands. But the mere fact that an earlier ‘machine’ or ‘manufacture,’ sold or used, was an experiment does not prevent its becoming an anticipation or a part of the prior art, provided it was perfected and thereafter became publicly known. Whether it does become so depends upon how far it becomes a part of the stock of knowledge of the art in question. \* \* \*”

Or as stated in *Pyrene Mfg. Co. v. Boyce*, 292 Fed. 480, at 485-6 (C. C. A. 3):

“\* \* \* In considering the several alleged prior uses set up by the respondent, we do not find that, within the authority of *Gayler v. Wilder*, 10 How. 477, 13 L. Ed. 504, they were ‘so far understood and practiced or persisted in as to become an established fact, accessible to the public and contributing definitely to the sum of human knowledge.’ ”

See also, *Radio Corporation of America v. Mackay Radio & Telegraph Co., Inc.*, 96 F. (2d) 587, 591 (C. C. A. 2).

## IIe.

The Patent in Suit Is Not Anticipated by U. S. Patent No. 2,097,851 to Wenzl or the French Patent No. 800,640, of 1936, to Jensen & Roser.

In its points of appeal [III. 1111] York Corporation has alleged that the District Court erred in not holding that the use of water to defrost at below freezing temperatures was taught by the prior Wenzl patent No. 2,097,851 [IV. 1272] and the Jensen & Roser French Patent No. 800,640 [IV. 1279].

Each of these patents fails to anticipate the patent in suit. Neither of them teaches the use of water for the defrosting of the refrigerator coils located in a space required to be constantly maintained below the freezing point of water.

The patent to Wenzl clearly does not anticipate the McAdam patent. No conduits for supplying water to the spray pipe or for draining the water from the unit are shown in this patent. Clearly, then, it does not antici-

pate the McAdam patent which is specifically limited to such self-draining conduits.

Further, while this Wenzl patent states that the outer surfaces of its cooling elements must never be higher than 0° (presumably Centigrade, the patentee being a German), no statement whatsoever is made concerning the temperature during defrosting. It is noted that the patent is stated to relate "to air coolers for effecting the lowering of temperature in rooms, public buildings, etc., in storage rooms, such as the cellars of breweries, rooms where perishable goods are kept." [p. 1, col. 1, ll. 1-5 of the Wenzl Patent, IV. 1275.]

It is obvious that such places as public buildings, cellars of breweries, etc., are not spaces continuously maintained below the freezing point of water. The temperature of the surface of the refrigerating coils therein is not proof of the temperature of the surrounding space. It is precisely upon this point, *i. e.*, the temperature during defrosting, that the problems solved by McAdam arise. The Wenzl patent being completely silent in this regard, therefore, cannot be an anticipation.

It is well settled that an indefinite prior patent cannot anticipate, *Ideal Roller & Mfg. Co. v. Sutherland Paper Co.*, 96 F. (2d) 675 (C. C. A. 6), and that a prior patent, in order to be an anticipation, must itself speak; its specification must give in substance the same knowledge and the same directions as the specification of the patent in suit, *Southern Phosphate Corporation v. Phosphate Recovery Corporation*, 102 F. (2d) 801 (C. C. A. 3). A patent which fails to solve the problem towards which the inventor's efforts are directed does not anticipate a patent which successfully solves a problem and effectively

accomplishes the desired result, *Williams Iron Works Co. v. Hughes Tool Co.*, 109 F. (2d) 500 (C. C. A. 10).

In failing to mention anything concerning temperature during defrosting the Wenzl patent fails to approach the problem solved by McAdam. This Wenzl patent, therefore, does not bear within its four corners adequate directions for the practice of the invention of the McAdam patent. It therefore clearly fails to anticipate the McAdam patent, *Dewey & Almy Chemical Co., et al., v. Mimex Co., Inc.*, 124 F. (2d) 986 (C. C. A. 2).

The French patent to Jensen and Roser likewise fails either to teach the use of water for defrosting a coil located in a space constantly maintained below the freezing point of water or to anticipate the McAdam patent. This French patent is very indefinite in its disclosure. The only thing said concerning defrosting is at IV. 1282, middle paragraph, wherein it is suggested that "whenever defrosting becomes necessary such operation may be readily effected either by a current of air obtained from outside the cooling chamber or by means of a circulation of water." The full text is:

"Whenever defrosting becomes necessary, such operation may be readily effected either by a current of air obtained from outside the cooling chamber or by means of a circulation of water. The stream of air or water passes through pipe 16 disposed above the container 2. This pipe is pierced with openings to permit the air or water to flow uniformly through the container and its pipes and into its passages."  
[IV. 1282.]

It is impossible to determine from this French patent how a "circulation of water" could be established. The water is presumably sprayed from the header formed by

the coil of pipe 16. This circle is outside the container 2 and the water would, therefore, be sprayed outside the container 2 and not upon the tubes forming the container. This water would flow downwardly and out of the pipe 18 and could not flow upwardly through the tubes and defrost them. All, therefore, that this patent contains is a mere "prophetic suggestion" as to what might be done with a circulation of water.

Nothing is better settled in the law than that such vague foreign patents cannot have effect as anticipating an invention patented in a United States patent.

This court, in *Carson v. American Smelting & Refining Co.*, 4 F. (2d) 463, 465 (C. C. A. 9) says:

"A foreign patent is to be measured as anticipatory, not by what might have been made out of it, but by what is clearly and definitely expressed in it. An American patent is not anticipated by a prior foreign patent, unless the latter exhibits the invention in such full, clear, and exact terms as to enable any person skilled in the art to practice it without the necessity of making experiments. *Seymour v. Osborne*, 11 Wall. 516, 555, 20 L. Ed. 33; *Hanifen v. Armitage* (C. C.) 117 F. 845; *Permutit Co. v. Harvey Laundry Co.* (C. C. A.) 279 F. 713; *General Electric Co. v. Hoskins Mfg. Co.*, 224 F. 464, 140 C. C. A. 150. In *Westinghouse Airbrake Co. v. Great Northern Ry. Co.*, 88 F. 258, 31 C. C. A. 525, the court said: 'The prophetic suggestions in English patents of what can be done, when no one has ever tested by actual and hard experience and under the stress of competition the truth of these suggestions, or the practical difficulties in the way of their accomplishment, or even whether the suggestions are feasible, do not carry conviction of the truth of these frequent and vague statements.'"



As said by the Supreme Court in *Seymour v. Osborne*, 11 Wall. (78 U. S.) 516 (1871):

“Patented inventions cannot be superseded by the mere introduction of a foreign publication of the kind, though of prior date, unless the description and drawings contain and exhibit a substantial representation of the patented improvement in such full, clear and exact terms as to enable any person skilled in the art or science to which it appertains to make, construct and practice the invention to the same practical extent as they would be enabled to do if the information was derived from a prior patent. Mere vague and general representations will not support such a defense, as the knowledge supposed to be derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention, and to carry it into practical use. Whatever may be the particular circumstances under which the publication takes place, the account published, to be of any effect to support such a defense, must be an account of a complete and operative invention capable of being put into practical operation.”

See also *Wisconsin Alumni R. Foundation v. George A. Breon & Co.*, 85 F. (2d) 166 (C. C. A. 8) (1936).

Like the Wenzl patent, this French patent is utterly silent as to the temperature conditions of the unit while defrosting. This French patent fails to approach the problem solved by McAdam and can have no effect upon the validity thereof.

“\* \* \* The record shows that the various parts of Carroll’s device were so interrelated and so co-acted as to bring about the desired result in an



eminently successful and satisfactory manner, and we see nothing in the record to show that any other device or apparatus ever before operated upon the same principle in accomplishing the same or a similar result. A device which does not operate on the same principle cannot be an anticipation. \* \* \*” (*Los Alamos Sugar Co. v. Carroll*, 173 F. 280 at 284 (C. C. A. 9)).

### III.

#### **The McAdam Patent Is for a Combination. Defense of Anticipation Must Be Addressed to the Combination.**

Appellants have fallen into the error to which all defendants in patent litigation are prone, for it is well established that it is not sufficient to show that each of the elements of a patented combination are separately old, but it is necessary to show *the combination* is old. The Circuit Court of Appeals, Sixth Circuit, in *Yesbera v. Hardesty Co.*, 166 Fed. 120, 125, has expressed this very aptly when it said:

“\* \* \* The point to be emphasized is that the law looks not at the elements or factors of an invented combination as a subject for a patent, but only to the combination itself as a unit distinct from its parts,  
\* \* \*.”

It is a well settled principle of patent law that:

“\* \* \* It is not sufficient to constitute an anticipation, that the device relied upon might, by modification, be made to accomplish the function performed by the patent in question, if it were not designed by its maker, nor adapted, nor actually used, for the performance of such functions.” (*Topliff v. Topliff*, 145 U. S. 156, 161.)

In *Western Electric Co. v. Home Telephone Co.*, 85 Fed. 649, the court, in discussing this principle of law, said at 656:

“The force of this ruling, and the similar ruling in *Clough v. Barker*, 106 U. S. 175, 1 Sup. Ct. 188, is made manifest, in its practical application to the rights of parties, by the reflection that all earlier patents set up in defense against a later patent sued upon are but the record evidence of the status the art has reached. The rights under such later patent are subject to what this record evidence *actually shows*. To change this record, by permitting theoretical modifications of these earlier patents, would be the same, in principle, as to change, by interpolation or modification, any other evidence between the parties.” (Emphasis supplied.)

This rule is well established.

See:

*Gunn v. Bridgeport Brass Co.*, 148 Fed. 239;

*Tubelt Co. v. Friedman*, 158 Fed. 430;

*Tannage Patent Co. v. Zahn*, 70 Fed. 1003 (C. C. A. 3);

*Ryan v. Newark Spring Mattress Co.*, 96 Fed. 100;

*Simonds R.-M. Co. v. Hathorn Mfg. Co.*, 90 Fed. 201, 208;

*Gormully & J. Mfg. Co. v. Stanley Cycle Mfg. Co.*, 90 Fed. 279.

IV.

**The York Corporation's "Unit Sold to Private Concerns" Infringes Claims 1, 2, 5, 6, 7, 8, 12 and 13\* of the Patent in Suit.**

The parties entered into a stipulation concerning the manufacture and sale to private citizens by the York Corporation of the refrigerating apparatus as described in the stipulation [Defts. Ex. CC, IV. 1527].

This unit as therein described [particularly at pages 1528-1529 of the transcript] embodies each and every element of each of the claims alleged to be infringed. This is immediately apparent from the claim charts [IV. 1538] offered in evidence by Refrigeration Engineering, which clearly illustrate the manner in which the York Corporation unit embodies the elements of the claims. York Corporation has never argued that its unit failed to respond to the claims of the patent in suit, but has predicated its argument of noninfringement on the suggestion that it does not supply one element of the claims, to-wit, the refrigerated space. This argument is not open to York Corporation. The stipulation clearly provides that York Corporation has supplied water defrosting connections with its standard section coil unit where the unit was installed to maintain the temperature well below freezing in the refrigerated space [IV. 1528].

In describing the units it has sold, the stipulation particularly refers to this "refrigerated space" [IV. 1529].

The stipulation, therefore, fully establishes infringement. No request for relief from the stipulation has ever been made. The stipulation is clearly binding upon the litigants. York Corporation's argument with respect to noninfringement is therefore clearly without merit.

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\*No charge of infringement of claims 3, 4, 9, 10, 11 or 14 was presented to, litigated or adjudged in the District Court.

V.

The District Court Erred in Concluding That Claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12 and 14 of the Patent in Suit Failed to Define the Entire Invention of the McAdam Patent.

York Corporation's declaratory judgment complaint alleged the total invalidity of the McAdam patent [I. 3, par. VIII]. The District Court adjudged the enumerated claims invalid as failing to define the complete invention [I. 24, par. 3; *cf.* Finding 48, I. 22; Conclusion 3, I. 23]. In this the court erred. Each of these claims definitely claims a combination and sufficiently points out and distinctly identifies each of the elements of the combination claimed by the claim.

It is to be noted that claims 2-6, inclusive, are dependent upon claim 1 and include all of the elements of claim 1, together with an additional element or elements. One element of each of these claims 1-6 is "a refrigerated space" [IV. 1432, col. 1, line 5]. The McAdam patent fully describes and discloses what is therein referred to as "a refrigerated space." The first sentence of the patent states "My invention relates to low temperature refrigeration where *a space is required to be constantly maintained at temperatures below the freezing point of water, \* \* \**" [IV. 1429, col. 1, lines 1-4; emphasis supplied]. The refrigeration coil is described [*id.*, 1430, col. 1, line 70, to col. 6, line 6], and it is stated: "While the scale of the drawings does not permit of showing a large compartment, the walls of such box or compartment are in part shown and indicated at 9, \* \* \*" etc. [*id.*, line 7 *et seq.*]. This is the chamber which "is required to be constantly maintained at temperatures below the freezing point of water, \* \* \*" just referred to. Each of these

claims also includes “valve means connected with \* \* \*”  
“a valve-controlled conduit.”

It is not apparent from the record herein upon what the District Court founded its conclusion that these claims failed to define the complete invention. The District Court did not find anticipation or want of invention. We must therefore await such criticism of the claims’ definition by York Corporation. The Refrigeration Engineering counsel are unable to find anything lacking in these claims or to understand what the District Court depended on as constituting the invalidity.

Claims 7 and 8 call for a combination of which “a refrigerated space” is one element. A self-draining water supply conduit is another element. The elements are clearly identified and specified. Claims 9, 12 and 14 are for combinations. Each of the elements is specified definitely and their inter-relation and purposes is set forth.

In claims 10 and 11 the combination is specifically limited to “a refrigeration space” which, after the recital in the claims of other elements, is referred to as follows: “\* \* \* whereby the air of said refrigerated space does not rise above the freezing point of water during the time required for defrosting said coil and fin surfaces, \* \* \*” [IV. 1432, col. 2, lines 8-11]. These claims also call for the self-draining conduits.

If the District Court’s objection to these claims was founded upon an asserted failure of these claims to specifically call, in so many words, for a refrigerated space *constantly maintained below the freezing point of water*,

the court clearly erred. The McAdam patent clearly states that it relates to refrigeration where a space is required to be constantly maintained at temperatures below the freezing point of water. Particularly, it would appear that the District Court overlooked the specific disclosure in claims 10 and 11 of the refrigerated space and the statement "whereby the air of said refrigerated space does not rise above the freezing point of water," etc.

The rule of interpretation is that the claims of a patent are to be construed in the light of the specification in order to secure to the inventor his real invention (*Deller's Walker on Pats.*, Vol. II, §261, p. 1242, and cases cited).

This Court has repeatedly applied this rule (*Henry v. City of Los Angeles*, 255 Fed. 769, 780 (C. C. A. 9); *McRoskey v. Braun Mattress Co.*, 107 F. (2d) 143 (C. C. A. 9)). In the last case cited, this Court pointed out that the only type of spring referred to in the specification of the patent in suit was a conical spring and therefore construed the claims as being limited to conical springs. In this case the only type of refrigerated space mentioned in the McAdam patent is a refrigerated space maintained constantly below the freezing point of water. Applying this rule, as in the *McRoskey* case, the claims are to be construed as limited to a refrigerated space constantly maintained below the freezing point of water and therefore clearly as defining the true McAdam invention (*cf. Carnegie Steel Co. v. Cambria Iron Works*, 185 U. S. 403, 432; *Oliver-Sherwood Co. v. Patterson-Ballagh Corp.*, 95 F. (2d) 70, 78 (C. C. A. 9)).



VI.

**The District Court Did Not Err in Denying Plaintiff's Motion to Amend Its Complaint.**

York Corporation, toward the close of the trial [III. 1053], made a belated motion to amend its complaint to state that "defendant is barred from the relief sought in the McAdam patent because it has misused the patent in an effort to control competition on unpatented devices." [III. 1053.] The District Court denied this motion [III. 1060, 1061, 1063]. There was no abuse of discretion in so doing. This alleged defense is predicated upon the doctrine laid down by the Supreme Court of the United States, particularly in *Mercoïd Corporation v. Mid-Continent Investment Co.*, 320 U. S. 661. In that case the court held that the owner of a patent on a combination could not enforce the patent where he was not manufacturing and selling the combination, but only one element thereof. York Corporation's position is that this doctrine is applicable here because Refrigeration Engineering, Inc., does not sell with its units the length of hose required to form a portion of the supply conduit and the drain conduit [III. 1100, 1101], and on the assertion by York Corporation that Refrigeration Engineering, Inc., does not sell "a refrigerated space." The testimony is clear that Refrigeration Engineering, Inc., has sold the hose and hose connections [III. 1100] and that other than omitting the length of hose in its current sales, it supplies the entire unit [III. 1100]. There is no other evidence as to how Refrigerating Engineering, Inc., does business. Accordingly, there was no evidence upon which the Court



could conclude that Refrigeration Engineering, Inc., was misusing the patent in suit. The motion was therefore denied because the proofs did not establish facts constituting patent misuse under this *Mercoïd* decision.

### Conclusion.

It is respectfully submitted:

(1) That the judgment of validity and infringement of claim 13 should be affirmed;

(2) That it is clear that each of claims 1-12, inclusive, and 14 clearly defines the combination of elements therein described and set forth with due particularity sufficiently to enable the court and one skilled in the art to identify such elements; that this is the maximum requirement as to sufficiency of definition in a claim; that the judgment should be reversed in so far as it adjudges that these claims "are invalid and void as failing to define the entire combination of the invention of the McAdam patent";

(3) That claims 1, 2, 5, 6, 7, 8, 9, 10 and 12 are clearly infringed by plaintiff-appellant; that the appealed judgment should be modified by inserting such a judgment therein; that the perpetual injunction provided for in said judgment be extended to and include these claims; and that paragraph VIII [l. 25-6] should be amended to include recovery of general damages, etc., under these claims;

(4) That the District Court did not err in denying York Corporation's belated motion to amend its complaint and to plead an alleged patent misuse by Refrigeration

Engineering, Inc.; that there has been no patent misuse by Refrigeration Engineering, Inc.; and

(5) That appellee and cross-appellant, Refrigeration Engineering, Inc., recover its costs and disbursements incurred upon these appeals.

Respectfully submitted,

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